

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FRANK YEH

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Appeal No. 97-0991  
Application 08/436,660<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 10 through 29, all of the claims pending in the application.

The invention relates to "a novelty drinking cup or mug

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<sup>1</sup> Application for patent filed May 8, 1995.

assembly that allows an individual to choose and change the ornamental design of the mug" (specification, page 1). Claim 10 is illustrative and reads as follows:

10. A mug assembly, comprising:

an external mug comprising a substantially cylindrical container wall having an inner surface, the external mug further comprising a mouth having a substantially circular upper edge;

an internal mug adapted to be positioned inside the external mug, the internal mug comprising a substantially cylindrical container wall having an outer surface and a substantially circular upper edge, the internal mug further comprising a sealing material attached adjacent the upper edge of the internal mug on the outer surface thereof, the sealing material adapted to engage a portion of the inner surface of the external mug;

wherein the diameter of the outer surface of the internal mug is smaller than the diameter of the inner surface of the external mug so that a second gap is defined when the internal mug is positioned inside the external mug; and

wherein the internal mug is made of a non-plastic material.<sup>2</sup>

The references relied upon by the examiner as evidence of anticipation and obviousness are:

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<sup>2</sup> The reference in claim 10 to "a second gap" should be amended to read as --a gap-- since this is the only gap mentioned in the claim.

Appeal No. 97-0991  
Application 08/436,660

Martin	2,895,636	Jul. 21, 1959
Todd	3,766,975	Oct. 23, 1973
Bernardi	4,151,923	May 1, 1979
Bradshaw	4,263,734	Apr. 28, 1981
Fine	4,789,073	Dec. 6, 1988
Saklad	5,150,815	Sept. 29, 1992

The claims on appeal stand rejected as follows:

a) claims 10, 21 and 29 under 35 U.S.C. § 102(b) as being anticipated by Fine;

b) claims 11, 13, 15, 19, 20, 22, 24, 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Fine in view of Todd;

c) claim 12 under 35 U.S.C. § 103 as being unpatentable over Fine in view of Todd, and further in view of Martin;

d) claims 14 and 23 under 35 U.S.C. § 103 as being unpatentable over Fine in view of Todd and Martin, and further in view of Bernardi;

e) claims 16 and 25 under 35 U.S.C. § 103 as being unpatentable over Fine in view of Todd, and further in view of Saklad;

f) claims 17 and 26 under 35 U.S.C. § 103 as being

Appeal No. 97-0991  
Application 08/436,660

unpatentable over Fine in view of Todd, and further in view of Bradshaw; and

g) claim 18 under 35 U.S.C. § 103 as being unpatentable over Fine in view of Martin.

Reference is made to the appellant's brief (Paper No. 9) and to the examiner's answer (Paper No. 10) for the respective

positions of the appellant and the examiner with regard to the merits of these rejections.

Fine, the examiner's primary reference, pertains to insulated beverage containers of the type having an inner liner and an outer shell which define therebetween an insulation and indicia display chamber. Fine's intent is to provide an improvement of the prior art container shown in Figures 1 and 2. This prior art container includes an inner liner A having a notch C at its upper end and an outer shell B having an upper edge D received within the notch. The liner and shell are affixed and sealed to one another by the inclusion of adhesive between notch C and edge D or by sonic welding along edge D (see column 3, lines 31 through 43).

According to Fine, this type of sealed connection suffers the disadvantages of being non-detachable and inefficient to produce (see column 1, lines 34 through 46). To overcome these problems, Fine provides the insulated beverage container shown in Figures 3 through 7. This container consists of an inner liner 11 having an over-hanging lip portion 13 at its upper edge and an outer shell 12 having a top edge portion 35 received within the over-hanging lip portion. The over-hanging

lip portion includes an inwardly projecting bead 14 and the upper edge of the shell includes outwardly protruding bands 27 and 28. The bead 14 is designed to be snap-fitted into the groove 36 defined by the bands 27 and 28 to form a detachable, fluid-tight joint between the liner and shell. Fine teaches that the liner 11 and shell 12 may be constructed of a plastic or other liquid-impervious insulating material and that the bead 14 and bands 27 and 28 may be formed of the same material as the liner and shell, respectively, or of a separate rubber material (see column 4, lines 59 through 63; and column 6,

lines 3 through 9).

With regard to the standing 35 U.S.C. § 102(b) rejection of claims 10, 21 and 29, anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

In support of this rejection, the examiner points to Fine's disclosure at "col. 4, lines 59+ regarding materials and Fig. 1 and 2 and col.3, lines 31+ regarding internal to external mug attachment" (answer, page 5). The examiner also explains that

[t]he mug assembly set forth in Figs. 1 and 2 of Fine employs an adhesive between notch C and edge D. This adhesive meets the sealing material limitation. The adhesive between the notch C and edge D, when the mug is assembled, will have a flat outer surface as the adhesive will be forced to assume the shape of the notch and edge, and coat a portion of the inner and outer surfaces of the notch. The coating of the inner and outer surfaces of the notch will occur due to the movement of the adhesive as the edge is placed in the notch, and forces the adhesive to fill any void between the notch and edge. Note the small tolerances between the notch and edge. Note the flat surfaces disclosed in Figs. 1 and 2. The adhesive material will provide for frictional engagement between the surfaces, at least at some point in the adhesive setting process. The claims

Appeal No. 97-0991  
Application 08/436,660

are not limited to the degree of frictional engagement, nor are the claims limited to when the frictional engagement occurs [answer, pages 7 and 8].

It is thus apparent that the examiner is relying on the portions of the Fine disclosure relating to the prior art container shown in Figures 1 and 2 to meet all of the limitations in claims 10, 21 and 29 except for those in independent claims 10 and 21 requiring the internal mug to be made of a non-plastic material. In this regard, Fine does not disclose that the internal mug or liner of the prior art container is made of a non-plastic material. To meet these limitations, the examiner relies on a portion of the Fine disclosure (column 4, line 59 et seq.) relating to the Fine container shown in Figures 3 through 7 which teaches that the inner liner or mug can be made of a material other than plastic. It is well settled, however, that

anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose and combine various portions of the disclosure not

directly related to each other by the teachings of the reference. In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). Since the portions of the Fine disclosure pertaining to the prior art container (Figures 1 and 2) and to the Fine container (Figures 3 through 7) are not directly related to each other by the teachings of the reference, the standing 35 U.S.C. § 102(b) rejection of independent claims 10 and 21, and of claim 29 which depends from claim 10, is not well founded.

This rejection is also unsound for additional reasons.

More particularly, Fine does not disclose a mug assembly having "a sealing material attached adjacent the upper edge of the internal mug on the outer surface thereof, the sealing material adapted to engage a portion of the inner surface of the external mug" as recited in independent claim 10. The examiner's determination that the adhesive between the notch C and edge D of the prior art container described by Fine meets this limitation is based on unsupported and unreasonable findings as to the properties and location of the adhesive. The Fine container (Figures 3 through 7) also lacks such a sealing material.



Fine also fails to disclose a mug assembly having "at least one strip of sealing material attached adjacent to the upper edge of the external mug on the outer surface thereof, the sealing material having a flat outer surface . . . wherein the flat outer surface of the sealing material is adapted to frictionally engage the flat internal surface of the overhanging lip [on the internal mug]" as recited in independent claim 21.<sup>3</sup> Here again, the examiner's determination that the adhesive between the notch C and edge D of the prior art container described by Fine meets this limitation is based on unsupported and unreasonable findings as to the properties and location of this adhesive. Moreover, while the Fine container (Figures 3 through 7) does have at least one strip of sealing material in the form of band 27 or band 28 attached adjacent to the upper edge of the external mug or shell on the outer surface thereof, neither band

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<sup>3</sup> As disclosed, the outer surface 50 of the sealing material 30 (or 31) and the internal surface 52 of the overhanging lip 46 are curved in a substantially cylindrical sense and thus are not actually "flat" within the ordinary and accustomed meaning of this term. Nonetheless, we understand the appellant's use of the term "flat" to define these surfaces to mean that the surfaces are flat when viewed in cross-section as shown, for example, in Figure 4.

Appeal No. 97-0991  
Application 08/436,660

appears to have a flat outer surface which is adapted to frictionally engage a flat internal surface of the overhanging lip 13.

Given the foregoing deficiencies of the Fine reference, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 10 and 21, or of claim 29 which depends from claim 10, as being anticipated by Fine.

Nor shall we sustain the standing 35 U.S.C. § 103 rejections of dependent claims 11 through 20 and 22 through 28. In short, the secondary references applied by the examiner in support of these rejections fail to cure all of the above noted shortcomings of Fine with respect to the subject matter recited in parent claims 10 and 21.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT                    )  
Administrative Patent Judge            )  
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Appeal No. 97-0991  
Application 08/436,660

JOHN P. McQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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Appeal No. 97-0991  
Application 08/436,660

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